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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,049	10/11/2000	Venkata R. Jagana	BEA9-2000-0005-US1	4959

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IBM CORPORATION
IP LAW DEPT, ED02-905
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BEAVERTON, OR 97006-6063

EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,049

Applicant(s)

JAGANA, VENKATA R.

Examiner

William C. Vaughn, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in regards to the Amendment and Reply received on 01 March 2005.

Response to Arguments

2. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-30 are is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 7, lines 10-19, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments and intangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding exemplary independent claim 1, the recitation means for communicating directly between the first and second hosts” is unclear as to what qualifies as directly communicating. It is the examiner’s position that directly communicating between the first host and second host could mean communicating with another host through which another device is between the two hosts. It is requested that the Applicant clarify whether or not there is intervention between the two hosts.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson, U.S. Patent No. 6,718,347 in view of Latif et al. (Latif), U.S. Patent No. 6,400,730.

8. Regarding **claim 1**, Wilson discloses the invention substantially as claimed. Wilson discloses *a system for communication between a first host and second host comprising: means for communicating between a first host and a storage area network using a area network protocol* [see Wilson, Figures 12, 13, 16, Col. 34, lines 49-67, Col. 35, lines 1-12]; *means for communicating between a second host and the storage area network using the area network protocol* [see Wilson, Col. 11, lines 15-47]; *and means for communicating directly between the first and second hosts using the protocol* using the area network protocol [see Wilson, Col. 11, lines 15-47, Col. 14, lines 12-39]. However, Wilson does not explicitly disclose means for

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communicating directly between the first and second hosts using the storage area network protocol in a non-ESCON protocol manner.

9. In the same field of endeavor, Latif discloses (e.g., methods and apparatus for receiving, translating and routing data packets between different protocols). Latif discloses storage area network protocol in a non-ESCON manner [see Latif, Col. 1, lines 35-44, Col. 2, lines 15-67, Col. 6, lines 6-67].

10. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Wilson's teachings of a method for use in a computer system including first and second computers and first and second storage systems with the teachings of Latif, for the purpose of providing a more efficient means for communication between different protocols [see Latif, Col. 1, lines 65-67 and Col. 2, lines 1-54]. Thus, Wilson provides motivation to combine by stating that there exists a need improve performance modifying existing ESCON protocol [see Wilson, Col. 14, lines 28-30].

Furthermore, Wilson also discloses that other standard conventional communication links between the storage controllers could be used [see Wilson, Col. 10, lines 28-52]. By this rationale **claim 1** is rejected.

11. Regarding **claim 2**, Wilson-Latif further discloses *wherein the storage area network protocol is a FICON protocol* (Latif teaches utilizing FCP (Fiber Channel Protocol)), [see Latif, Col. 2, lines 15-34]. The same motivation that was utilized in claim 1, applies equally as well to claim 2. By this rationale **claim 2** is rejected.

12. Regarding **claims 3**, Wilson-Latif further discloses *wherein the means for communicating comprises: means at the first host for translating between the storage area network protocol and*

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a host- to-host communications protocol selected from the group consisting of TCP/IP [see Latif, Col. 6, lines 23-37] *and SNA* (The Examiner takes Official Notice (see MPEP 2144.03), that it would have been obvious to one of ordinary skill in the networking art at the time the invention was made for the communication protocol selection to have included SNA since SNA can be and is used with TCP/IP as well as being utilized at the data link layer and thus since Wilson does provide for the teachings of the data link layer that defines the physical format in which data is to be transferred to and/or from the network), [see Wilson, Col. 32, lines 49-54]. By this rationale **claim 3** is rejected.

13. Regarding **claims 4-6**, the limitations of these claims are substantially the same as that of claims 1-3 and thus are rejected for the same rationale in rejection of claims 1-3.

14. **Claims 7-18**, list all the same elements of claims 1-6, but in method form rather than system form. Therefore, the supporting rationale of the rejection of claims 1-6 applies equally as well to claim 7-18. Furthermore with regards to the limitations of *encapsulating TCP/IP packets from the first host in 8232 protocol frames* (Latif teaches encapsulation that is over a high speed network), [see Latif, Col. 6, lines 23-37]; *transmitting the 8232 protocol frames to the second host using the FICON protocol* [see Latif, Col. 6, lines 23-37]; *and decapsulating the TCP/IP packets from the 8232 protocol frames at the second host* [see Latif, Col. 11, lines 57-63].

15. Regarding **claims 19-30**, list all the same elements of claims 1-6, but in article for communicating form rather than system form. Therefore, the supporting rationale of the rejection of claims 1-6 applies equally as well to claim 19-30.

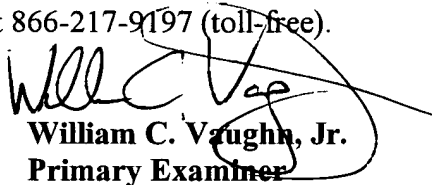
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (571) 272-3922. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William C. Vaughn, Jr.
Primary Examiner
Art Unit 2143
08 June 2005

WCV